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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,634	03/13/2002	Geoff S. Chalmers	18360/236825	3718
826	7590	03/31/2006	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			ZURITA, JAMES H	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/098,634

Applicant(s)

CHALMERS ET AL.

Examiner

James H. Zurita

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 2-10 and 13-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 11, 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Prosecution History***

The following is presented to clarify the record.

On 13 March 2002, applicant filed the instant application, claiming priority to provisional application 60/275861, filed on 14 March 2001. The application was published on 17 October 2002 as PG-PUB 20020152093.

On 6 April 2005, the Examiner issued a restriction/election requirement.

On 1 July 2005, applicant elected claims 1, 11 and 12.

On 23 September 2005, the Examiner issued a non-final rejection.

On 21 December 2005, applicant amended claims 1 and 11.

On 30 December 2005, the Office issued a Notice of Non-Compliant Amendment under 37 CFR 1.121.

On 25 January 2006, applicant corrected the amendment.

### ***Response to Amendment***

Applicant's submission of 25 January 2006 has been entered. Applicant amended claims 1 and 11.

Claims 1-64 are pending. Claims 2-10 and 13-64 are withdrawn from consideration by restriction. Claims 1, 11-12 will be examined.

### ***Response to Arguments***

Applicant's arguments filed 25 January 2006 have been fully considered.

Objections to the drawings are withdrawn in view of amendment.

Objections to the Specifications are withdrawn in view of amendment.

Rejection under 35 USC 101 is withdrawn in view of *In re Lundgren*.

Applicant argues:

...either the "Return Merchandise Authorization number" or the "bar code tag" as the Examiner pointed out in *Hauser* is clearly distinct from the "package tracking number" of the present application. As described in the specification, paragraph 63, a package tracking number 375 is assigned to identify a return transaction and "when the package is shipped, the parties to the transaction can track the progress of the package through the carrier system using the package tracking number 375".

In response to these arguments, the Examiner respectfully reminds applicant that he amended claim 1 from *package tracking number* to *package tracking identifier*.

Applicant also argues,

...Different from [applicant's] package tracking number, neither the "Return Merchandise Authorization number" nor the "bar code tag" in *Hauser* provides an ability of tracking returned merchandise during shipment by a carrier. Given this significant distinction, Applicant respectfully submits that *Hauser* does not disclose the element of "package tracking number" as included in Claims 1 and 11 and thus does not anticipate these claims.

In response, the Examiner respectfully directs applicant's attention to at least Col. 2, lines 49-67, which discloses tracking handling of returned merchandise through its final disposition. See also Col. 7, lines 30-37.

Concerning claim 12, Applicant argues:

... even assuming *Hauser* and the ALIS Press Release are combinable, the combined teachings do not disclose all claimed features in Claim 12, such as the package tracking number, saving shipping labels in a carrier server, etc. Therefore, Applicant respectfully submits that Claim 12 is [not?] obvious over over *[sic]* *Hauer* in view of the ALIS Press Release.

In response to these comments, a "traverse" is a denial of an opposing party's allegations of fact.<sup>1</sup> The Examiner respectfully submits that applicants' arguments and

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<sup>1</sup> Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

comments do not appear to traverse that the references are properly combined. The Examiner also notes that applicant does not appear to traverse the assertion that

...storing information on a carrier server permits customer service representatives and shippers using a carrier's network to be better equipped to respond quickly and accurately to package inquiries.

Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Please note that these rejections are necessitated by applicant's comments, since it appears that applicant claims patentability based on the specific format of a label and its contents. The claims refer to shipping label. Applicant refers to various labels, including Fig. 6, item 400 (RETURN SHIPPING LABEL and RETURN SERVICE LABEL, as in paragraph 78).

For purposes of examination, the term shipping label will be given its broadest reasonable interpretation as referring to a return authorization shipping label.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Hauser et al. (US 6,536,659).

***As per claim 1***, Hauser discloses method(s) of electronically providing a shipping label to a customer that wishes to return a good that was previously purchased from a merchant, said method comprising the steps of:

**initiating** a return transaction upon receipt of a return service request, wherein said return service request contains shipping information, said shipping information comprising an address of said customer and an address of said merchant. See, for

example, at least Fig. 1, item 12, Col. 3, lines 43-63, Col. 3, line 65-Col. 4, line 15, Fig. 1, items 20-24.

**assigning** a package tracking identifier to said return transaction, wherein said package tracking identifier is generated by a carrier for tracking progress of said return transaction. See, for example, at least Col. 3, line 65-Col. 4, line 15. See also references Return Merchandise Authorization number, as in Col.3, lines 43-64.

**generating** said shipping label based at least in part on said shipping information and said package tracking identifier, said shipping label including said package tracking identifier: Col. 3, lines 43-64.

**providing** said shipping label to said customer in electronic form. See, for example, at least Col. 4, lines 16-35, Col. 8, lines 45-54, email attachment.

**As per claim 11, Hauser discloses storing** an electronic image of said shipping label. See, for example, at least Fig. 1, item 18 and related text.

**sending** to said customer a *label delivery* link through which said customer obtain access to said stored electronic image. Col. 8, lines 45-54, the email has a link to an attached document. the link is used to deliver the label to be used for shipping.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser in view of Caminiti, Alan, Lyons, Cheryl, United Parcel Service Introduces Advanced

Label Imaging System, published by Business Wire on 29 November 1989, sec. 1, page 1, downloaded from the Internet on 19 September 2005.

**As per claim 12**, Hauser does not specifically disclose that the electronic image of a shipping label is stored on a carrier server. This feature is disclosed by Caminiti, which stores images of shipping labels on the server of a carrier like UPS. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hauser and Caminiti to disclose that an electronic image of a shipping label is stored on a carrier server.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Hauser and Caminiti to disclose that an electronic image of a shipping label is stored on a carrier server for the obvious reason that customer service representatives and shippers using a carrier's network may be better equipped to respond quickly and accurately to package inquiries.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not



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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Fadok can be reached on 571-272-6755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*J2*  
**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
28 March 200

*WLG*  
*ACTING SPE 3625*  
*MARK FADOK*